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EXAMINER	
SHRESTHA, BIJENDRA K	
ART UNIT	PAPER NUMBER
3691	

NOTIFICATION DATE	DELIVERY MODE
11/12/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/816,120	GAUBATZ ET AL.	
	Examiner	Art Unit	
	BIJENDRA K. SHRESTHA	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 July 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10,21-30 and 44-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10,21-30,44-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-10, 21-30 and 44-46 are presented for examination. Applicant filed an amendment on 07/06/2009 amending all the claims. After careful consideration of applicant amendments and arguments, new ground of rejections necessitated by applicant amendments has been established in the instant application as set forth in detail below. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10, 21-30 and 44-46 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4 and 12-21 of copending Application No. 10/594,993. Although the conflicting claims are not identical, they are not patentably distinct from each other because '993 application in claims 1, 4 and 12-21 teaches all the elements in claims 1-10, 21-30 and 44-46 in the instant application.

This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

As per claims 1, 21 and 44 of instant application, claims 1 and 12 applications '993 teach identifying one or more risk classes associated with the plurality of financial products; determining, for each of the risk classes, an expected occurrence rate, dividing the expected occurrence rates by an average rate to determine a relative risk ratio for each of the risk classes, calculating correlated risk ratios between at least two of the risk classes and comparing the relative risk ratios and the correlated risk ratios characterizing the relative risks associated with the plurality of products.

As per claims 2-10, 20-30 and 45-46 of instant application, claims 4 and 13-21 of applications '993 teach modifying criteria and recalculation, redefining risk classes, determining a separate relative risk ratio for a sub-groups of risks, storing data, comparing the prevalence data and adjusting stored data and determining an impact on a risk class using relative risk ratio.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-30 and 44-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specification do not describe identifying unit, determining unit (first, second, third, and fourth), dividing unit, calculating unit, comparing unit, modifying unit, adjustment unit. Appropriate correction is required.

Examiner interprets identifying, determining, dividing, calculating, comparing, modifying and adjustment is performed by software for the prosecution of this application.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-30 and 44-46 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, claims 21 and 44 recite in the preamble “a system having at least one hardware processor….” the body of the claim does not contain any limitations indicating the structure of the system. A system or an apparatus claim should always claim the structure or the hardware that performs the function. Applicant’s claimed limitations consist of “an identifying unit, a determining unit, a dividing unit, a calculating unit, a comparing unit”. The specification did not describe these units except steps of identifying, determining, dividing, calculating and comparing without specifying whether

these steps are performed by a software or hardware. Appropriate correction is required.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-10 and 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flagg, U.S. Patent No. 6,456,979 (reference A in attached PTO-892) in view of Moller et al. (BMJ, June 1995) (reference U in attached PTO-892).

3. As per claim 1 and 21, Flagg teaches a method of characterizing relative risks associated with a plurality of financial products performed on a computer having a hardware processor, comprising the steps of:

a) identifying one or more risk classes associated with the plurality of financial products by using an input device of the computer (see Fig. 2, step 60 (gender based risk class), step 80 (lifestyle/health profile base risk class));

Flagg does not teach b) determining, for each of the risk classes, an expected occurrence rate; c) dividing the expected occurrence rates by said step of determining by an average rate *to determine a relative risk ratio for each of the risk classes* and calculating correlated risk ratios between at least two of the risk classes that are identified in said step of identifying *to determine a dependence between the at least two*

different risk classes; and comparing the relative risk ratios and the correlated risk ratios by the processor *to characterize the relative risks associated with the plurality of products*.

Moller et al. teach b) determining, for each of the risk classes, an expected occurrence rate; c) dividing the expected occurrence rates determined in step of determining by an average rate (Moller et al., Table, Expected, Relative Risk, paragraph 3; where expected occurrence and relative risk ratio of cancer in Denmark for period 1977-89 is shown) and calculating correlated risk ratios between at least two of the risk classes that are identified in said step of identifying (see Table, page 1 and 2, column Observed No; where correlation between number of observed number of different types of cancer to data of 7046 people with primary diagnosis of Parkinson's disease in Denmark, 1977-89); and comparing the relative risk ratios and the correlated risk ratios (Moller et al, Table, Relative Risk, page 1-2; where Table illustrate comparison of "Observed Number" of specific cancer to 7046 people with Parkinson's disease in column 2 to "Relative Risk with 95% confidence interval" in column 4).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to include b) determining, for each of the risk classes, an expected occurrence rate; c) dividing the expected occurrence rates determined in step of determining by an average rate and calculating correlated risk ratios between at least two of the risk classes that are identified in said step of identifying; and comparing the relative risk ratios and the correlated risk ratios of Flagg because Moller et al. teach

including above feature would enable to assess the occurrence of risks large cohorts of patients (or plurality of products).

The claim language *" to determine a relative risk ratio for each of the risk classes, to determine a dependence between the at least two different risk classes, and to characterize the relative risks associated with the plurality of products*" represent intended use language and therefore do not carry any patentable weight (see MPEP form paragraph 7-37-09).

4. As per claim 2 and 22, Flagg in view of Moller et al. teach claim 1 as described above. Flagg further teach the system and method, wherein said one or more risk classes are associated with one or more criteria, and further comprising

the steps of modifying one or more of said criteria and repeating said steps of determining, dividing, calculating and comparing (see Fig. 2; where risk classes are based on gender and lifestyle/health profiles).

The claim language *"to determine an impact of said modification on the relative risks associated with the products*" pertains to intended use language that do not carry any patentable weight (see MPEP form paragraph 7-37-09).

5. As per claim 3-5 and 23-25, Flagg in view of Moller et al. teach claim 1 as described above. Flagg further teach the system and method, wherein

one or more of said risk classes are associated with different criteria (see Fig. 2; where risk classes are based on gender and lifestyle/health criteria)

Flagg does not teach relative risk ratios are used to compare said risk classes, the step of using the relative risk ratio to redefine one or more of said risk classes and the step of determining a separate relative risk ratio for sub-groups of risks.

Moller et al. teach relative risk ratios are used to compare said risk classes, the step of using the relative risk ratio to redefine one or more of said risk classes and the step of determining a separate relative risk ratio for sub-groups of risks (Moller et al, Table, Relative Risk column, page 1, paragraph 4; where relative ratio of different types of cancer risks are compared).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to include relative risk ratios are used to compare said risk classes of Flagg because Moller et al. teach including above feature would enable to assess the occurrence of risks large cohorts of patients (or plurality of products).

6. As per claim 6 and 26, Flagg in view of Moller et al. teach claim 1 as described above. Flagg further teach the system and method comprising

the step of storing data in a data storage of said computer relating to prevalence of criteria associated with said risk classes (see Fig. 1; column 23, lines 23-29; where server stores insurance prevalence criteria as shown in Fig.2).

The claim language "*for use in determining the relative risk ratios*" pertains to intended use language that does not carry any patentable weight (see MPEP form paragraph 7-37-09).

7. As per claim 7and 27, Flagg in view of Moller et al. teach claim 6 as described above. Flagg further teach the system and method comprising

the steps of comparing the prevalence data to industry empirical data for particular combinations of criteria and, if necessary, adjusting the stored data to agree with the empirical data (see Fig. 2, steps 70 and 90).

8. As per claim 8 and 28, Flagg in view of Moller et al. teach claim 1 as described above. Flagg further teach the system and method, comprising

the step of storing data relating to the expected occurrence rates (see Fig. 1, client data server; where server can store any data)

The claim language "*for use in determining the relative risk ratios*" pertains to intended use language that does not carry any patentable weight (see MPEP form paragraph 7-37-09).

9. As per claim 9 and 29, Flagg in view of Moller et al. teach claim 8 as described above. Flagg further teach the system and method, comprising

the steps of comparing the stored data to industry empirical data and, if necessary, adjusting the stored data to agree with the empirical data (see Fig. 2. lines 48-53; Fig.12, column 25, lines 5-9).

10. As per claim 10 and 30, Flagg in view of Moller et al. teach claim 2 as described above. Flagg further teach the system and method,

Flagg <u>does not the step of using the relative risk ratio.</u>

Moller et al. teach the step of using the relative risk ratio (Moller et al, Table, Relative Risk column, page 1, paragraph 4; where relative ratio of different types of cancer are compared).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include the step of using the relative risk ratio of Flagg because Moller et al. teach including above feature would enable to assess the occurrence of risks of large cohorts of patients (or plurality of products).

The claim language "*to determine an impact on a risk class of including in that class one or more risks that do not meet one or more of the criteria associated with that class*" pertains to intended use language that does not carry any patentable weight (see MPEP form paragraph 7-37-09).

11. As per claim 44, Flagg in view of Moller et al. teach claim 1 and 21 as described above.

Flagg further teaches means for comparing the risk and excluding the individual risk form the risk class, in a case where the comparing unit has determined that the class ratio is not acceptable (see Fig. 2; where risk compared include gender and lifestyle/health based)

Flagg does not teach comparing relative risk ratio of the individual to the relative risk ratio of the risk class

Moller et al. teach means for comparing relative risk ratio of the individual to the relative risk ratio of the risk class (Moller et al., Page 1-2, Table)

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include comparing relative risk ratio of the individual to the relative risk ratio of the risk class of Flagg because Moller et al. teach including above

feature would enable to assess the occurrence of risks of large cohorts of patients (or plurality of products).

The claim language "*to determine a class ratio*" pertains to intended use language that does not carry any patentable weight (see MPEP form paragraph 7-37-09).

12. As per claim 45-46, Flagg in view of Moller et al. teach claim 44 as described above. Flagg further teach the system, wherein

one or more of said risk classes are associated with a plurality of criteria (see Fig. 2, step 60 (gender based risk class), step 80 (lifestyle/health profile base risk class);

Flagg does not teach determining relative risk ratios for subgroups of criteria and means for comparing the relative risk ratio of the individual to the relative risk ratio of the risk class comprises comparing the relative risk ratio of the individual to one or more of the relative risk ratios determined for the subgroups of criteria.

Moller et al. teach determining relative risk ratios for subgroups of criteria and means for comparing the relative risk ratio of the individual to the relative risk ratio of the risk class comprises comparing the relative risk ratio of the individual to one or more of the relative risk ratios determined for the subgroups of criteria (Moller et al, Table, Relative Risk column, page 1, paragraph 4; where relative ratio of different types of cancer risks are compared including subgroups other skin cancer, all other specified cancer and cancer associated with tobacco smoking).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to include determining relative risk ratios for subgroups of criteria and means for comparing the relative risk ratio of the individual to the relative risk ratio of the risk class comprises comparing the relative risk ratio of the individual to one or more of the relative risk ratios determined for the subgroups of criteria of Flagg because Moller et al. teach including above feature would enable to assess the occurrence of risks large cohorts of patients (or plurality of products).

Response to Arguments

After careful consideration of applicant amendments and arguments, new ground of rejections necessitated by applicant amendments has been established in the instant application. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Examiner respectfully disagrees that Moller et al. do not teach correlation between risk classes. Moller et al. teach correlation between different types (classes) of cancer to data of 7046 people with primary diagnosis of Parkinson's disease (Moller et al., Table, page 1-2, Observed Number) and correlation between the different classes of cancers with respect to Parkinson’s disease is available from the Table.

Examiner would like to direct applicant attention to **intended use language** in claims 1-4, 6, 8, 10, 21-22, 24-30 and 44-46 of the instant application as described above. These limitations are not positively claimed, and therefore, are not given any patentable weight. A recitation of the intended use of the claimed invention must result

in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim (see MPEP form paragraph 7-37-09).

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosures. The following are pertinent to current invention, though not relied upon;

Abrahams et al. (U.S. Pub No. 2008/0091490) teach system for managing risk.

Buckner et al. (U.S. Pub No. 2003/0236685) teach preferred life mortality systems and methods.

DeTore et al. (U.S. Patent No. 4,975,840) teach method and apparatus for evaluating a potentially insurable risk.

Gaubatz et al. (U.S. Pub No. 2003/0101132) teach system and method for developing loss assumptions.

Gunewardena et al. (U.S. Pub No. 2003/0023543) teach method, software program, and system for ranking relative risk of plurality of transactions.

Fickes (U.S. Pub No. 2005/0262014) teaches relative valuation systems.

Messmer et al. (U.S. Pub No. 2004/0225587) teach risk categorization in underwriting a financial risk instrument application.

Otvos (U.S. Patent no. 6,576,471) teaches analyzing risk assessment result.

Robertson et al. (U.S. Pub No. 2004/0024620) teach risk classification methodology.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bijendra K. Shrestha whose telephone number is (571) 270-1374. The examiner can normally be reached on 8:00 AM-4:30 PM (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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10/28/2009